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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,281	07/25/2006	Fumihiro Hayashi	073759-0017	4907

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EXAMINER	
VO, HAI	

ART UNIT	PAPER NUMBER
1794	

MAIL DATE	DELIVERY MODE
10/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/587,281	HAYASHI ET AL.	
	Examiner	Art Unit	
	Hai Vo	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 October 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) *5-20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4 and 21-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *01/24/2007 and 07/25/2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Election/Restrictions

1. Applicant's election of Group I, claims 1-4, and 21-24 in the reply filed on 10/02/2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-4, and 21-24 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 2004108322. Okuda et al (US 2006/0141159) will be relied on as an equivalent form of WO 2004108322. Okuda teaches an anisotropic electrically conductive film comprising an expanded porous PTFE film with a plurality of through holes therein and a conductive metal applied to wall surfaces of the through holes (figure 3f). The expanded porous PTFE has a microstructure composed of fine fibrils and nodes connected by the fibrils and

elastic recovery property in the thickness direction (paragraph 83). Okuda does not specifically disclose the film having a residual strain and elastic modulus set forth in the claims. It appears that Okuda uses the same material and the same processing steps such as extruding, rolling, stretching, sintering and compressing as Applicants for forming the expanded porous PTFE of the present invention (paragraphs 81-83 and figures 4A-B). Therefore, it is not seen that the residual strain and elastic modulus could have been outside the claimed ranges as like material has like property.

The recitation "cushioning material", "sealing material" or "intracorporeally implanting material" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Accordingly, Okuda anticipates or strongly suggests the claimed subject matter.

5. Claims 1-4, and 21-24 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 2004-265844. Masuda et al (US 2006/0251871) will be relied on as an equivalent form of JP 2004-265844. Matsuda teaches an anisotropic electrically conductive film comprising an expanded porous PTFE film with a plurality of through holes therein and a conductive metal

applied to wall surfaces of the through holes (figure 7). The expanded porous PTFE has a microstructure composed of fine fibrils and nodes connected by the fibrils and elastic recovery property in the thickness direction (paragraphs 9, 11 and 52). Matsuda does not specifically disclose the film having a residual strain and elastic modulus set forth in the claims. It appears that Matsuda uses the same material and the same processing steps such as extruding, rolling, stretching, sintering and compressing as Applicants for forming the expanded porous PTFE of the present invention (paragraphs 51, 64). Therefore, it is not seen that the residual strain and elastic modulus could have been outside the claimed ranges as like material has like property.

The recitation "cushioning material", "sealing material" or "intracorporeally implanting material" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Accordingly, Matsuda anticipates or strongly suggests the claimed subject matter.

6. Claims 1-4, and 21-24 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 2005003866. Hayashi et al (US 2007/0160810) will be relied on as an equivalent form of WO 2005003866.

Hayashi teaches an electrically conductive film comprising an expanded porous PTFE film with a plurality of through holes therein and a conductive metal applied to wall surfaces of the through holes (paragraph 68). The expanded porous PTFE has a microstructure composed of fine fibrils and nodes connected by the fibrils and elastic recovery property in the thickness direction (paragraphs 43 and 44). Hayashi does not specifically disclose the film having a residual strain and elastic modulus set forth in the claims. It appears that Hayashi uses the same material and the same processing steps such as extruding, rolling, stretching, sintering and compressing as Applicants for forming the expanded porous PTFE of the present invention (paragraphs 51, 64). Therefore, it is not seen that the residual strain and elastic modulus could have been outside the claimed ranges as like material has like property.

The recitation "cushioning material", "sealing material" or "intracorporeally implanting material" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Accordingly, Hayashi anticipates or strongly suggests the claimed subject matter.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

   A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

   Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-4 and 21-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5 and 6 of copending Application No. 10/551,459. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '456 application teaches each and every limitation except for a residual strain and elastic modulus recited by the claims. It appears that the '456 application uses the same material and the same processing steps such as extruding, rolling, stretching, sintering and compressing as the present invention for forming the expanded porous PTFE of the present invention (paragraphs 51, 64). Therefore, it is not seen that the

residual strain and elastic modulus could have been outside the claimed ranges as like material has like property. The recitation "cushioning material", "sealing material" or "intracorporeally implanting material" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 1-4 and 22-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5 and 6 of copending Application No. 10/562,447. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '447 application teaches each and every limitation except for a residual strain recited by the claims. It appears that the '447 application uses the same material and the same processing steps such as extruding, rolling, stretching, sintering and compressing as the present invention for forming the expanded porous PTFE of the present invention (paragraphs 51, 64). The expanded porous PTFE has an elastic modulus within the claimed range. Therefore, it is not seen that the residual strain

could have been outside the claimed range as like material has like property. The recitation "cushioning material", "sealing material" or "intracorporeally implanting material" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 1-4 and 21-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5 and 6 of copending Application No. 10/586,341. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '341 application teaches each and every limitation except for a residual strain and elastic modulus recited by the claims. It appears that the '341 application uses the same material and the same processing steps such as extruding, rolling, stretching, sintering and compressing as the present invention for forming the expanded porous PTFE of the present invention. Therefore, it is not seen that the residual strain and elastic modulus could have been outside the claimed ranges as like material has like property. The recitation "cushioning material", "sealing material" or "intracorporeally

implanting material" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. WO 2005003866, an equivalent form of Oyama (US 2006/0154010), has a publication date of July 28, 2005 that is after an effective filing date of the present application as of April 7, 2005. The WO '693 is not prior art against the claimed invention.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on Monday through Thursday, from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HV

/Hai Vo/
Primary Examiner, Art Unit 1794